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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,094	06/01/2001	Travis J. Parry	10005949-1	3103

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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EXAMINER

MYHRE, JAMES W

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 10/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/873,094	Applicant(s) PARRY ET AL.	
	Examiner James W. Myhre	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed on September 2, 2005 has been considered but is ineffective to overcome the Sato et al (US 2001/0037267 A1), Weinblatt (5,401,946), and Wegman et al (6,418,283) references. The amendment did not add, cancel, or amend any claims, but did amend the specification. Thus, the pending claims considered below remain Claims 1-36.

Specification

2. The amendment filed on September 2, 2005 amended the specification on page 6, line 5 to correct a typographical error objected to in paragraph 2 of the previous Office Action. Therefore, the Examiner hereby withdraws that objection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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4. Claims 1, 3-5, 7-13, 16-22, 25, 27-29, and 31-34 are rejected under 35

U.S.C. 102(e) as being anticipated by Sato et al (US2001/0037267).

Claims 1, 10, 12, 13, 17, 18, 25, and 33: Sato discloses a method, apparatus, and program for promoting the use of consumables, comprising:

a. detecting consumption of one or more consumables in one or more imaging devices using a consumption detecting device (page 4, paragraphs 0079, 0080, and 0098; page 6, paragraph 0119; page 7, paragraph 0125; and page 8, paragraph 0136);

b. rewarding the user of the imaging device(s) when the consumption of a predefined quantity has been reached (Figure 16); and

c. Notifying the user of the reward by displaying a reward message on the display (Figure 16).

Claims 3, 19, 20, 27, and 34: Sato discloses a method, apparatus, and program for promoting the use of consumables as in Claims 1, 17, 25, and 33 above, and further discloses receiving the reward certificate through a global computer network connection (Figure 2; page 4, paragraph 0098; and page 11, paragraphs 0181-0182).

Claims 4 and 28: Sato discloses a method and program for promoting the use of consumables as in Claims 3 and 27 above, and further discloses that receiving the reward over the global computer network is performed automatically upon reaching the predetermined usage level of the consumable (page 11, paragraphs 0181-0182).

Claims 5 and 29 Sato discloses a method and program for promoting the use of consumables as in Claims 1 and 25 above, and further discloses calculating an estimated consumption of the consumable (pages 9-10, paragraphs 0162-0174).

Claim 7: Sato discloses a method for promoting the use of consumables as in Claim 1 above, and explicitly discloses the consumable having a standard price and the user reward is a discount (percentage off) over the standard price (Figure 16).

Claims 8, 21, and 31: Sato discloses a method apparatus, and program for promoting the use of consumables as in Claims 1, 17, and 25 above, and further discloses counting the sheets of consumable media (e.g. paper)(page 7, paragraph 0125 and page 8, paragraph 0136).

Claims 9, 22, and 32: Sato discloses a method, apparatus, and program for promoting the use of consumables as in Claims 1, 17, and 25 above, and further discloses calculating the amount of image forming substance (e.g. toner) consumed by the imaging device (page 4, paragraph 0098 and page 6, paragraph 0119).

Claims 11 and 16: Sato discloses a method for promoting the use of consumables as in Claims 10 and 12 above, and further discloses basing the value of the reward on the value of the individual consumable (by rewarding a percentage of the consumable's cost)(Figure 16).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 14, 26 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al (US2001/0037267) in view of Weinblatt (5,401,946).

Claims 2, 14, 26, and 36: Sato discloses a method, apparatus, and program for promoting the use of consumables as in Claims 1, 12, 25, and 33 above, but does not explicitly disclose that the reward is a coupon printed on the imaging device. However, Weinblatt discloses a similar method, apparatus, and program for promoting the use of consumables in which a coupon is printed as a reward for reaching a predetermine usage level of the consumable (col 13, line 67 – col 14, line 4). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to print a coupon on the imaging device being monitored in Sato. One would have been motivated to print the coupon in order to allow the user to receive the earned reward when purchasing replacement consumables at local physical stores.

7. Claims 6, 15, 23, 24, 30, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al (US2001/0037267) in view of Wegman et al (6,418,283).

Claims 6, 15, 23, 24, 30, and 35: Sato discloses a method, apparatus, and program for promoting the use of consumables as in Claims 1, 12, 17, 25, and 33 above, but does not explicitly disclose identifying the source of the consumable and basing the reward on the identified source. However, Wegman discloses a similar method, apparatus, and program for promoting the use of consumables which also identifies the source of each consumable and bases the reward on the source (rebate offer)(col 5, line 61 – col 6, line 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to identify the course in Sato and to base the reward (percentage discount) on the source. One would have been motivated to identify the source in Sato in view of Sato's disclosure of identifying the consumable cartridge by cartridge type ID and serial number (placed on the cartridge by the source/manufacturer)(page 7, paragraph 0123) and to base the reward on the source in order to allow the source/manufacturer to provide rebates for returning the cartridges as discussed in Wegman.

Response to Arguments

8. Applicant's arguments filed September 2, 2005 have been fully considered but they are not persuasive.

The Applicant argues in reference to Claim 1 (pages 14-16), Claim 10 (pages 16-17), Claim 12 (pages 17-18), Claim 17 (pages 18-19), Claim 25 (pages 19-20) and Claim 33 (pages 20-21) that Sato does not disclose "rewarding a user of the imaging device with a reward defined by a value" or that the value of the reward is based "on the individual quantities of each consumable that has been detected as being consumed by the imaging device". The Applicant argues that the billing statement in Figure 16 is not a reward. The Examiner notes that Figure 16 depicts a billing statement (invoice) which show the total number of consumables consumed by the imaging device within the time period, the basic charge, the unit price per print, and a **discount amount**, which the specification discloses is a volume discount "for a user who consumes an enormous number of supplies" (page 4, paragraph 0080). Thus, Sato explicitly discloses rewarding a user with a reward value (volume discount) based on the quantity of consumables detected as being consumed by the imaging device.

The Applicant argues in reference to the 35 U.S.C. 103 obvious rejections of Claims 2, 6, 14, 15, 23, 24, 26, 30, 35, and 36 that these claims are also allowable for the same reason as the claims above, but presents no arguments as to the additional features in these claims. Since the Examiner has shown that Sato does disclose the argued features above, these claims also remain rejected.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (571) 272-6722. The examiner can normally be reached Monday through Thursday from 5:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (571) 272-6724. The fax phone number for Formal or Official faxes to Technology Center 3600 is (571) 273-8300. Draft or Informal faxes, which will not be entered in the application, may be submitted directly to the examiner at (571) 273-6722.

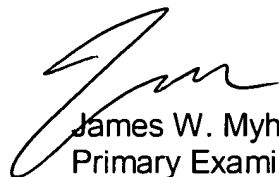
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (571) 272-3600.



JWM

October 24, 2005



James W. Myhre
Primary Examiner
Art Unit 3622